

10/613,220 filed 07/02/2003

Wada, et al,

Reply to Office Action of October 6, 2005

### REMARKS/ARGUMENTS

Claims 1-23 are pending in the instant application. All of the pending claims were rejected in the Office Action. With this paper, claim 1 has been amended. No new matter was added with the amendment.

I. Claim rejection under 35 U.S.C. § 103(a) as being unpatentable over Nelson et al. (US 6,007,690) in view of Spence et al. (US 6,540,895)

Claims 1-23 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nelson et al. (US 6,007,690) in view of Spence et al. (US 6,540,895). These rejections are traversed.

To warrant rejection under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art. See MPEP § 2142. With regard to Applicants' independent claim 1, at a minimum, Nelson et al. do not teach a second microscale channel configured to contain a particle set therein that is downstream from a first microscale channel comprising a gel filled component separation region. The limitation that the second channel is downstream from the first channel has been added to more particularly point out and distinctly claim Applicants' invention. Support for the limitation can be found throughout the specification, as well as being illustrated in Figure 1. Thus, no new matter has been added by the amendment of the claim. Applicants wish to point out that the term "downstream" is defined by Applicants on page 10, in paragraph 0045.

On page 2 of the Office action, the Examiner interprets channel 236 of Figure 18 of Nelson et al. as a gel separation region. Therefore, channel 236 would be, by the Examiner's interpretation, equivalent to the first microscale channel of Applicants' claim 1. The Examiner then states on page 3 of the Office action, "the enrichment channel can employ paramagnetic beads that are coated with affinity medium and can be retained in the channel...." The enrichment channel of Figure 18 (as well as Figures 15-17) is identified as channel 230. As can be seen in Figure 18, channel 230 is clearly upstream from channel 236. This is further supported in column 18, lines 16-32, which describe the direction of flow within the device.

Spence et al. do not teach a second microscale channel configured to contain a particle set therein that is downstream from a first microscale channel comprising a gel filled component separation region. Therefore, Spence et al. cannot supply the limitation missing from

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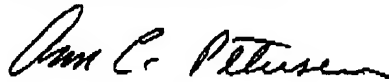
Nelson et al. As a result, the combination of Nelson et al. and Spence et al. neither teaches nor suggests all of the limitations of Applicants' amended claim 1. Thus, claim 1 is nonobvious. Withdrawal of the rejection of independent claim 1 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nelson et al. (US 6,007,690) in view of Spence et al. (US 6,540,895) is respectfully requested.

Claims 2-23 depend directly or indirectly from amended independent claim 1. Any claim depending from a nonobvious claim is also nonobvious. See MPEP § 2143.03 and *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent claims 2-23 are nonobvious. Withdrawal of the rejections of these claims under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nelson et al. (US 6,007,690) in view of Spence et al. (US 6,540,895) is also respectfully requested.

#### Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned attorney.

Respectfully submitted,



Ann C. Petersen  
Reg. No. 55,536

CALIPER LIFE SCIENCES, INC.  
605 Fairchild Drive  
Mountain View, CA 94043  
Direct: 650-623-0667  
Fax: 650-623-0504  
ann.petersen@caliperLS.com

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Signed: 